IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Aalim LAKHANI, et al.   Confirmation No. 8697

Serial No: 09/943,061   Group Art Unit: 2161

Filed: August 30, 2001   Examiner: Te Y. CHEN

For: METHOD AND SYSTEM FOR E-COMMERCE PACKAGES

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Dear Sir or Madam:

Pursuant to 37 C.F.R. § 41.41, Appellant submits this Reply Brief in response to the

Examiner's Answer mailed on November 27, 2006.

I.   REAL PARTY IN INTEREST

A statement identifying the real party in interest is contained in the Appeal Brief.

II.   RELATED APPEALS AND INTERFERENCES

A statement identifying the related appeals and interferences is contained in the Appeal

Brief.

III.   STATUS OF CLAIMS

A statement identifying the status of the claims is contained in the Appeal Brief.

IV.   STATUS OF AMENDMENTS

A statement identifying the status of amendments is contained in the Appeal Brief.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the claimed subject matter is contained in the Appeal Brief.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A statement identifying the grounds of rejection to be reviewed on appeal is contained in the Appeal Brief.

VII.   RESPONSE TO EXAMINER'S ANSWER

A.   Examiner's 1st Response

In response to Appellant's argument that the cited references do not, alone or in combination, disclose, teach, or suggest "a catalog database comprising a catalog entry table including package data correlated to at least one unresolved package, wherein the at least one unresolved package includes one or more products with at least one unresolved attribute," as recited in claim 1, the Examiner states:

> The Examiner disagrees with Appellant's piecemeal interpretation and arguments against the 35 U.S.C. § 103(a) rejections. The main arguments are summarized as following: "Mikurak and Wyatt do not, alone or in combination, disclose, teach, or suggest "a catalog database comprising a catalog entry table including package data correlated to at least one unresolved package, wherein the at least one unresolved package includes one or more products with at least one unresolved attribute".

In reply to the above arguments, the examiner directs Appellant's attention to the following Figures and excerpts of Mikurak:

For example at Figure 121, Mikurak clearly discloses an on-line shopping e-commerce system for enabling the purchase of package products data, which comprises an integrated framework as shown in Fig. 53 and processing logical flows as shown in Fig(s). 54-55, via an open electronic communication network such as Internet, electronic commerce LAN, merchant LAN, and payment service Network as described in Fig. 121, wherein, the network data communication is using the claimed Packet processing [e.g., the packet filter Router technique at Fig. 121], and the application database of Fig. 121 is deemed to have tables for storing the catalog products information of web service applications as shown by the units: 5300, 5324 of Fig. 53.

(November 27, 2006 Examiner's Answer, pgs. 6-7).

Based on the Examiner's comments, it appears that the Examiner misunderstood some of the arguments Appellant set forth in the appeal brief. Hence, to assist the Examiner in understanding Appellant's arguments, Appellant will distill claim 1 down in simpler terms. Claim 1, in its simplest terms, involves a "package" that includes a "product" with an "unresolved attribute."

Although Mikurak discusses allowing users to purchase a "predetermined set of items," the "predetermined set of items" in Mikurak cannot be construed as disclosing, teaching, or suggesting the "package" recited in claim 1. In particular, the present application describes a "package" as:

[A] single atomic unit, for which a single price can be charged. Once a package has been selected by a consumer . . . , only the fully resolved package (and not its constituent item components) is added to his or her 'shopping cart' (as will be understood). As a result, the constitute components cannot be modified. The consumer . . . can choose to increase the number of packages to be purchased, or can remove the package from the order.

(Pg. 13, lns. 7-12 of the Specification) (emphasis added).

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Mikurak, on the other hand, teaches that "the user is allowed to modify the predetermined set of items that are selected" (col. 96, lns. 58-60 of Mikurak). In other words, users are allowed to add items to or remove items from the "predetermined set of items" in Mikurak. Hence, the "predetermined set of items" in Mikurak cannot be construed as disclosing, teaching, or suggesting the "package" recited in claim 1 because Mikurak allows users to remove items from or add items to the "predetermined set of items," whereas the "package" recited in claim 1 is clearly described in the specification as a single atomic unit that cannot be modified.

In case the Examiner is tempted to respond to Appellant's argument by stating that "limitations from the specification are not read into the claims" or that "claims are to be given their broadest reasonable interpretation," Appellant respectfully reminds the Examiner that the broadest reasonable interpretation must be "consistent with the specification" (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*)), and must be "in light of the specification as it would be interpreted by one of ordinary skill in the art" (See *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004)).

To construe the term "package" so broadly as to be something that is modifiable would not only be inconsistent with the specification, but would also not be an interpretation that one of ordinary skill in the art would give in light of the specification. Specifically, the present application states:

> [A]pplicants have recognized that there may be promotional and other advantages to be gained if merchandise and/or services could be grouped together. From the consumer's perspective, group purchases may involve price discounts or other incentives for volume purchases as well as making purchasing decisions easier. From the merchant's perspective, grouping merchandise together may result in increased sales volume, and may assist in promoting new or low volume products with more popular, high volume products.

There is accordingly a need for a system and methodology for enabling the e-commerce purchasing of grouped merchandise and/or services (hereinafter referred to as "packages").

(Pg. 1, lns. 16-24 of the Specification). Thus, the term "package" cannot be construed so broadly as to be something that is modifiable because it would be contrary to the purposes for having a "package" in the first place (e.g., motivate buyers to buy a less desirable merchandise with a more desirable merchandise).

Even assuming argumentatively that the "predetermined set of items" in Mikurak can be construed as disclosing the "package" recited in claim 1, the "predetermined set of items" in Mikurak cannot be construed as disclosing, teaching, or suggesting the "unresolved package" recited in claim 1 because the "unresolved package" in claim 1 is a "package" that includes a "product" with an "unresolved attribute." Mikurak does not disclose, teach, or suggest that any of the "items" in the "predetermined set of items" has an "unresolved attribute."

Although Mikurak discusses allowing users to select a "feature" of an "item," the "feature" in Mikurak cannot be construed as disclosing, teaching, or suggesting the "attribute" recited in claim 1. Specifically, the present application states:

The sample data contained in the tables 500, 502, 504, 506, 508, 510 has been included for illustrative purposes and references gloves and sweater merchandise. In the sample data, the gloves may be purchased in two materials, leather and vinyl. As well, the sweaters in the example are available in two colours, blue and green, and also come in two sizes, small and large. These options with respect to the sweaters and gloves are referred to throughout herein as attributes. In the example provided, sweaters have two attributes, size and colour, while gloves have a single attribute, material.

(Pg. 5, lns. 9-15 of the Specification). Hence, the "attribute" recited in claim 1 is something that is needed to identify the particular merchandise a user wants to purchase. As a result, if any "attribute" of a "product" is "unresolved," then there would be nothing to sell because a

merchant will not be able to identify the particular merchandise that a user wants to buy. For instance, if the "material attribute" of the "glove" product is unresolved, then the merchant will not be able to determine whether the user wants to purchase a "leather glove" or a "vinyl glove."

In contrast, Mikurak states:

> Each of the items includes a plurality of available features which are displayed in operation 6003, preferably with the price of each feature, including cost for adding the feature and cost savings for removing the feature.

(Col. 100, lns. 18-21 of Mikurak). Hence, a "feature" need not be selected for an "item" in Mikurak to be an identifiable merchandise that can be purchased because users are able to purchase an "item" without selecting any "features."

In the Examiner's Answer, the Examiner states:

> The examiner further disagrees with Appellant's argument that "In the present invention, "the at least one unresolved attribute" has to be resolved before payment can even be arranged since only fully resolved packages can be added to a shopping cart . . . Thus, Mikurak fails to disclose, teach, or suggest any products having at least one unresolved attribute, as recited in claim 1."
> In reply to these arguments, it is noted that the feature upon which applicant relies (i.e., the at least one unresolved attribute has to be resolved before payment can even be arranged since only fully resolved packages can be added to a shopping cart) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(November 27, 2006 Examiner's Answer, pg. 10).

As discussed above, even though "limitations from the specification are not read into the claims" and "claims are to be given their broadest reasonable interpretation," the Federal Circuit has held that the broadest reasonable interpretation must be "consistent with the specification" (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*)), and

must be "in light of the specification as it would be interpreted by one of ordinary skill in the art" (See *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004)).

To construe the term "attribute" so broadly as to be something that is not necessary to identify the particular merchandise a user wants to purchase would be inconsistent with the specification and would not be an interpretation that one of ordinary skill in the art would give in light of the specification.

Since the "feature" in Mikurak cannot be construed as disclosing, teaching, or suggesting the "attribute" recited in claim 1, Mikurak does not disclose, teach, or suggest that any of the "items" in the "predetermined set of items" has an "unresolved attribute." Consequently, the "predetermined set of items" in Mikurak cannot be construed as disclosing, teaching, or suggesting the "unresolved package" recited in claim 1.

Accordingly, Mikurak does not disclose, teach, or suggest an "unresolved package [that] includes one or more products with at least one unresolved attribute," as recited in claim 1.

B.   Examiner's 2nd Response

In response to Appellant's argument that the cited references do not, alone or in combination, disclose, teach, or suggest "a selection module coupled to the catalog database for allowing a customer to select an unresolved package for purchase," as recited in claim 1, the Examiner states:

> In addition, Mikurak clearly discloses a selection module coupled to the catalog database for allowing a customer to select an unresolved package for purchase [e.g., the shopping Cart technique of 5300, Fig. 53 and Fig. 55 associated texts].

(November 27, 2006 Examiner's Answer, pg. 7).

Since Mikurak does not disclose, teach, or suggest "unresolved package [that] includes one or more products with at least one unresolved attribute," as recited in claim 1, Mikurak necessarily fails to disclose, teach, or suggest "allowing a customer to select an unresolved package for purchase," as recited in claim 1, because such an "unresolved package" does not exist in Mikurak. If an "unresolved package" does not exist in Mikurak, then it is not something that a customer can select for purchase.

Therefore, Mikurak fails to disclose, teach, or suggest "a selection module coupled to the catalog database for allowing a customer to select an unresolved package for purchase," as recited in claim 1.

C. Examiner's 3rd Response

In response to Appellant's argument that the cited references do not, alone or in combination, disclose, teach, or suggest "a resolution module coupled to the catalog database for resolving the at least one unresolved attribute of the one or more products in the selected unresolved package by accessing the package data correlated to the selected unresolved package," as recited in claim 1, the Examiner states:

> Moreover, Mikurak discloses his system comprises a resolution component [e.g., the problem handling module 1502, Fig. 21] that handles troubles reported by customers, identifies causes and provides resolutions as shown in Fig. 21.
> Furthermore, Mikurak clearly discloses the claimed unresolved package communication which definitely includes one or more products with at least one unresolved attribute as shown by the order handling unit that correlates with invoice/collections, customer enquiries & enquiries resolution units to create or delete <u>the attributes of customer account</u> for the selected orders accordingly as shown in Fig. 25 and associated texts.

(November 27, 2006 Examiner's Answer, pgs. 7-8).

First of all, the "resolution module" recited in claim 1 is used to resolve an "unresolved attribute" of a "product." Therefore, it is irrelevant that Mikurak has a "problem handling process 1502" that the Examiner asserts "handles troubles reported by customers, identifies causes and provides resolutions" to the troubles reported by customers.

Appellant is at a loss as to how "troubles reported by customers" is in any way related to an "unresolved attribute" of a "product." Appellant is also at a loss as to how "invoice/collections, customer enquiries & enquiries resolution units to create or delete the attributes of customer account" is in any way related to an "unresolved attribute" of a "product."

Secondly, if Mikurak does not disclose, teach, or suggest "unresolved package [that] includes one or more products with at least one unresolved attribute," as recited in claim 1, then there would be no need for Mikurak to have a "resolution module" that resolves an "unresolved attribute" of a "product" since there aren't any "unresolved attributes" in Mikurak.

In the Examiner's Answer, the Examiner further states:

> In order to assist Appellant to appreciate that the prior art on record details the claimed limitations of resolving the unresolved attribute of products in a package by accessing the package data correlated to the selected unresolved package, the examiner further points out a second patent issued to Wyatt that discloses an e-commerce system as shown in Fig. 3, wherein the e-commerce system accesses the package data correlated to the selected unresolved package as shown in Fig. 7 with excepts recited as following:
> "In one embodiment of the invention, the digital token is associated with the data at a server computer system prior to being transmitted to a recipient client server system. The association of a digital token to particular data indicates that the data has been validly requested and received by the client computer system 12 from the server computer system 14. A valid

request in one embodiment of the invention includes requesting the data and making payment for the requested data, in which case the server computer system attaches the digital token to the requested data prior to transmitting the requested data to the client computer system. This digital token is subsequently used by the client computer system to determine whether-the data has been validly purchased." (col. 7, lines 37-50)

"To control the client computer system's access to requested data which has been received from the server computer system, one or more computer instructions are also associated with the data stored in the storage device during the wrapping step 34 as illustrated at step 84. These computer instructions essentially "wrap" the requested data by embedding the requested data within the computer instructions such that the data cannot be extracted without successfully executing the computer instructions. In one embodiment of the invention, the computer instructions are organized into an executable file such that the computer instructions are performed when an attempt is made to access the data." (col. 7, lines 51-63)

Here, Wyatt clearly details the argued limitations for a resolution module [e.g., the use of server module as shown in Fig. 3] to resolve (or validate) the unresolved attribute (e.g., the digital token 169, Fig. 7) of a product order request, the system accesses the digital token attribute (169, Fig. 7) that is correlated with the selected package products identified by the Stock Keeping Unit (SKU) as shown in Fig. 7 prior to transmit the ordered package to the client system.

Since Mikurak and Wyatt are both the same endeavour to provide a resolution module for resolving the unresolved package occurred in an e-commerce system [e.g., Mikurak: the shopping cart technique of 5300, Fig. 53 and Fig. 55 associated texts; Wyatt: the server module of Fig(s). 3, 7, and associated texts]. Thus, with the teachings of Mikurak and Wyatt in front of him/her, it would have been obvious for a ordinary skilled person in the art, at the time the invention was made to be motivated to modify Mikurak's shopping cart resolution module with the client/server technique as taught by Wyatt, for the purpose of providing an upgraded resolving module in the combined system that facilitates the direct accessing of the unsolved package data for the combined on-line shopping cart selection and thereby ensures only when the resolution module (e.g., the server) completes the resolution of the unsolved attribute by accessing the unsolved attributes (e.g., a digital token) associated with the selected unresolved product package then the package will be automatically wrapped and launched for transmission to the client upon purchase.

(November 27, 2006 Examiner's Answer, pgs. 8-9).

In order to assist the Examiner to appreciate that, contrary to the Examiner's assertions, the cited references do not, alone or in combination, disclose, teach, or suggest the elements of claim 1, Appellant has simplified claim 1 down to a "package" that includes a "product" with an "unresolved attribute."

As discussed above, Mikurak does not disclose, teach, or suggest a "package" that includes a "product" with an "unresolved attribute." Given that Mikurak does not disclose, teach, or suggest a "package" that includes a "product" with an "unresolved attribute," it necessarily follows that Mikurak would have no need for any "resolution module" that resolves an "unresolved attribute" of a "product."

With respect to Wyatt, Wyatt does not disclose, teach, or suggest the "package" recited in claim 1. Although a "data package" is mentioned in the claims and in the summary of the invention section in Wyatt, Wyatt does not disclose, teach, or suggest that the "data package" includes more than one "software product." In particular, claim 4 of Wyatt states "allowing access to the user selected data package only if the product activation code is present." Typically, each "software product" has its own "product activation code." Hence, the language in Wyatt suggests that the "data package" includes only one "software product."

In addition, it is not inherent that the "data package" in Wyatt includes more than one "software product." Under M.P.E.P. § 2163:

> To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

(M.P.E.P. § 2163.07, 8th ed., 5th rev.).

Since the "data package" in Wyatt does not necessarily include more than one "software product" and the "package" recited in claim 1 necessarily includes more than one "product," the "data package" in Wyatt cannot be construed as disclosing, teaching, or suggesting the "package" recited in claim 1. To construe the term "package" in claim 1 so broadly as to be something that may include only a single "product" would be inconsistent with the specification and would not be an interpretation that one of ordinary skill in the art would give in light of the specification because it would defeat the purposes of having a "package" in the first place (e.g., group an unpopular merchandise with a popular merchandise in order to sell more of the unpopular merchandise).

Even assuming argumentatively that the "data package" in Wyatt can be construed as disclosing the "package" recited in claim 1, contrary to the Examiner's assertions, the "digital token" in Wyatt cannot be construed as disclosing, teaching, or suggesting the "attribute" recited in claim 1.

In particular, as pointed out by the Examiner, the "digital token" in Wyatt is used to determine whether a user has a right to access to a "software product," such as a software program. Hence, the "digital token" is not needed to identify which "software product" the user wants to buy. In addition, the "software product" in Wyatt is identified using a SKU, as noted by the Examiner, not the "digital token." As a result, the "digital token" in Wyatt cannot be construed as an "attribute" of the "software product."

Therefore, Wyatt also fails to disclose, teach, or suggest a "package" that includes a "product" with an "unresolved attribute." Consequently, Wyatt would also have no need for any "resolution module" that resolves an "unresolved attribute" of a "product," since there aren't any "unresolved attributes" in Wyatt.

Accordingly, based at least on the reasons above, Mikurak and Wyatt, do not, alone or in combination, disclose, teach, or suggest the elements of claim 1. Since claim 10, 15, and 17 recite elements similar to those of claim 1, Mikurak and Wyatt also fail to disclose, teach, or suggest the elements of claim 10, 15, and 17 for at least the same reasons.

CONCLUSION

On the basis of the above remarks, and the remarks made in the Appeal Brief, Appellant respectfully submits that the final rejection should be reversed.

Respectfully submitted,

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Dated: March 16, 2007

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VIII. APPENDIX OF CLAIMS

A listing of the claims involved on appeal is contained in the Appeal Brief.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None